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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Zhongyi Li et al.

Serial No.: 10/577,564 Examiner: Brent Page

Filed : April 27, 2006 Group Art Unit: 1638

For : RICE AND PRODUCTS THEREOF HAVING STARCH WITH AN INCREASED PROPORTION OF AMYLOSE

30 Rockefeller Plaza
New York, New York 10112
December 22, 2009

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PETITION UNDER 37 C.F.R. §1.144
FROM REQUIREMENT FOR RESTRICTION

This Petition submitted under 37 C.F.R. §1.144 requests withdrawal of the requirement for restriction of claims 15, 16, 17, 18 and 20 made "final" in the July 23, 2009 Office Action issued in connection with the above-identified application.

Pursuant to 37 C.F.R. §1.144, this Petition is being filed no later than appeal of the above-identified application. More specifically this Petition is being filed concurrently with a response to the July 23, 2009 first action on the merits. Accordingly, this Petition is being timely filed.

Requirements of a Petition Under 37 C.F.R. §1.144

A petition under 37 C.F.R. §1.144 must contain pursuant to 37 C.F.R. §1.181 a statement of the facts involved, the point or points to be reviewed, and the action requested.

Statement of the Facts Involved and the Point or Points to be Reviewed and the Action Requested

1. Statement of Facts Involved

In a February 19, 2009 Office Action, the Examiner required restriction to one of the following groups under 35 U. S. C. §121:

I. Claim(s) 1-6, 8-14, 40, 41, and 43 drawn to a grain obtained from rice wherein the rice grain comprises a reduced level of SBEIIa and SBEIlb and comprises a transgene and a method of producing a rice starch thereon.

II. Claim(s) 1-4, 7-17, 24, 37 and 40 drawn to a grain obtained from rice wherein the rice grain comprises a reduced level of SBEIla and SBEIlb and comprises introducing variations via mutagenizing or identifying null mutants, including Wxa.

III. Claim(s) 18-20, drawn to a starch or starch granule and flour.

In response, applicants filed on March 19, 2009 an Amendment electing, with traverse, to prosecute the invention of Examiner's Group I, drawn substantially to a rice grain obtained from a rice plant wherein the rice grain comprises a

reduced level of SBEIIa and SBEIIb and comprises a transgene and a method of producing a rice starch therefrom. However, applicants specifically traversed the restriction of claims 15, 16, 18 and 20 from Group I.

Also in their March 19, 2009 Amendment, applicants amended claim 15 to clarify that the grain of claim 2, which is within Group I, "further" comprises a null mutation of SBEIIa and SBEIIb. Thereby clarifying that claim 15 should be within elected Group I.

Applicants further explained that claim 16 defines elements of claim 1 within Group I and that there was no basis of record to restrict claim 16 from claim 1.

Applicants also amended claims 18 and 20 into independent form explicitly reciting all of the limitations of claim 1 within Group I.

Finally, applicants expressly stated on the record in their March 19, 2009 Amendment that rice starch granules of applicants' invention (i.e. claims 18 and 20) are not patentably distinct from the rice grain of applicants' invention and should therefore be examined with elected Group I.

July 23, 2009 Office Action

In a July 23, 2009 Office Action, the Examiner made "Final" the restriction of claims 15, 16, 17, 18 and 20 from elected Group I.

Point to be Reviewed

M.P.E.P. §803, "Restriction – When Proper" provides:

> Under the statute, the claims of an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 802.01, §806.06, and § 808.01) or distinct (MPEP § 806.05 - § 806.05(j)).
>
> If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.

M.P.E.P. §803 "Guidelines" provides:

> If there is an express admission that the claimed inventions would have been obvious over each other within the meaning of 35 U.S.C. 103, restriction should not be required. *In re Lee*, 199 USPQ 108 (Comm'r Pat. 1978).

In their March 19, 2009 Amendment, applicants traversed the restriction of claims 15, 16, 18 and 20. Applicants amended claim 15 to clarify it is within Group I. Applicants explained that claim 16 properly belonged within Group I and that there was no basis of record to restrict claim 16 from claim 1. Finally, applicants stated for the record that the rice starch granules of applicants' invention recited in claims 18 and 20 are not patentably distinct from the rice grain of applicants' invention.

Applicants hereby again expressly admit that the invention recited in claims 17, 18 and 20, and the invention recited in

claim 1, each claim as amended and presented in applicants' December 22, 2009 Amendment filed concurrently herewith, are obvious over each other.

Accordingly, restriction of claims 15, 16, 17, 18 and 20, as presented in applicants' December 22, 2009 Amendment, from Group I is improper and should be reversed.

3. Action Requested

In conclusion, applicants respectfully request reversal of the restriction of claims 15, 16, 17, 18 and 20 from elected Group I.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

No fee is deemed necessary in connection with the filing of this Petition. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited on this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to:

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Gary J. Gershik 12/22/09

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